

REMARKS

The claims are replaced with new claims. The new claims are directed to a more specified embodiment within the scope of the previous claims. The more specified claims are clearly supported by the original specification, e.g., see page 7, line 34; page 8, line 15; page 9, lines 26 and 36; page 10, lines 7 and 12; page 15, lines 6-8; and all of the Examples. The method claims non-elected pursuant to the restriction requirement are canceled. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The reasons set forth in the Reply filed November 3, 2008, and entered upon filing of the RCE on December 23, 2008, remain applicable for overcoming the sole outstanding ground of rejection and are incorporated by reference here. In fact, the reasons for overcoming the rejection should be even more convincing in light of the new claims. Previously, applicants provided a Declaration under 37 C.F.R. §1.132 showing the unexpected advantages of applicants' invention as proof of their nonobviousness. In the Final Office action, the showing was said to be not convincing on the grounds that it was not commensurate in scope with the claims. There should be no question now that the showing is commensurate in scope with the claims as presented above. The claims have been specified essentially to the exact embodiment shown in the Declaration to have unexpected advantages. There is no longer any issue of whether the showing in the declaration of the clear and significant advantages of the embodiment having 37% castor oil is reasonably representative of the maximum of the claimed range because, under the above claims, the maximum amount of castor oil is 37%. The recited ratio of castor oil to benzyl benzoate of 1:1.7 by volume dictates that the maximum amount of castor oil by volume is 37%.

Further, the claims are specified to the specific testosterone ester and the specific co-solvent for which the showing in the Declaration is made. The law and PTO guidelines only require that the showing be reasonably representative of the advantage(s) of the claimed invention over the cited prior art; see, e.g., In re Kollman, 201 USPQ 193 (CCPA 1979); In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980); and MPEP §2145. In view of the high specificity of the claims, the fact that the Declaration shows an advantage of one embodiment does not detract from its convincing nature. The claims are essentially specified to the exact embodiment which the Declaration shows to be advantageous. The advantage in stability of the compositions, when using the lower amount of castor oil as recited in the instant claims, could not have been expected from the prior art. Neither reference teaches any advantage in stability for its compositions. Further, to the extent Riffkin suggests to use castor oil in the WO '383 compositions, it only suggests to use it in amounts of 50% or higher. Thus, the advantage in stability of the solutions for applicants' invention using a lower amount of castor oil was clearly unexpected over the prior art teachings. This unexpected advantage provides clear and convincing proof of the nonobviousness of applicants' invention.

It is believed that the claims are in condition for allowance. However, the examiner is kindly invited to contact the undersigned by telephone to discuss matters which may further the prosecution of this application or facilitate the allowability of some or all of the claims herein.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.: PLOVIN-0010

Date: February 10, 2009
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